

## REMARKS

Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested. It is respectfully submitted that the amendments to the claims raise no new issues that would require a new search. Claims 8 and 18 have been amended merely to put them in independent form. Claim 1 has been amended merely to clarify that the mirror can be selectively introduced into the beam paths.

### **Status of the Claims**

Claims 1-5 and 7-18 are pending. Claim 6 was cancelled in a previous amendment. Claims 3-5, 7, and 12 have been withdrawn from consideration.

Claims 8 and 18 have been amended to be in independent form. Claim 1 has been amended. Support for the amendment to claim 1 may be found, for example, in the Specification on page 8, line 19, through page 9, line 8. No new matter has been added.

### Allowable Subject Matter

Applicant appreciatively thanks the Examiner for the indication of allowable subject matter recited in claims 2, 8-9, 14-16 and 18. Applicant has amended claims 8 and 18 to be in independent form, and submits that claims 8 and 18 are in condition for allowance. Claim 9 depends from claim 8, and thus, Applicant submits that dependent claim 9 is patentable for at least the same reasons as base claim 8.

**Rejection under 35 U.S.C. §102(b)**

Claims 1, 10-11, and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Publication No. 2002/0109101 to Hoffman. In the present Office Action, the Examiner contends that Hoffman's dichroic beam splitter 27 reads on the mirror recited in claim 1, "at least in so far as it was guided into place during assembly." See Detailed Action, Item 3, paragraph 2, lines 7-10.

Hoffman describes a scanning microscope having a first light source 17 which generates an excitation light beam 19, and a second light source 21, which generates an emission light beam 23. The excitation light beam 19 and the emission light beam 23 are combined by a dichroic beam combiner 25 and travel along illumination beam path 41 to the scanning module 29 through a dichroic beam splitter 27. See Hoffman, paragraph 0027 and Figure 2.

Claim 1, as amended, recites a mirror which can be "selectively introduced" in guided fashion into the illumination and detection beam paths at a position in the illumination and detection beam paths.

It is respectfully submitted that Hoffman fails to teach a selectively introducible mirror, as recited in claim 1. In contrast, the beam splitter 27 of Hoffmann is always disposed in the beam path 41 to direct the combined excitation light beam 19 and emission light beam 23 to the scanning module 29. Beam splitter 27 must always be disposed in the beam path 41; otherwise no light at all would reach the scanning module 29. See Hoffman, paragraph 0027, lines 6-10 and 18-20, and Figure 2. The beam splitter 27 of Hoffmann cannot be "selectively introduced" into the beam path 41, since it is always present in the beam path. Thus, Hoffman fails to teach "a mirror which can

be selectively introduced in guided fashion into the illumination and detection beam paths.” as recited in independent claim 1.

Because Hoffmann fails to teach each and every feature recited in claim 1, it cannot anticipate claim 1. Claims 10-11 and 17 depend from claim 1. Applicant submits that dependent claims 10-11 and 17 are patentable for at least the same reasons as base claim 1.

In view of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 10-11, and 17 under 35 U.S.C. §102(b) based on Hoffmann.

**Rejection under 35 U.S.C. §103**

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hoffmann in view of U.S. Patent Publication No. 2002/0020800 to Knebel et al. (“Knebel”). Applicants respectfully traverse the rejection.

Claim 13 depends from claim 1. It is respectfully submitted that Knebel neither discloses nor teaches the above-recited features of claim 1 demonstrated to be missing from Hoffmann, *i.e.*, a mirror that can be “selectively introduced in guided fashion into the illumination and detection beam paths at a position in the illumination and detection beam paths.” Because each of Hoffmann and Knebel is missing at least the above-recited features of independent claim 1, a combination of these references, to the extent proper, could not render claim 13 obvious.

Reconsideration and withdrawal of rejection of claim 13 under 35 U.S.C. §103(a) based on Hoffmann and Knebel is respectfully requested.

CONCLUSION

Each and every point raised in the Final Office Action mailed February 6, 2007 has been addressed on the basis of the above remarks. In view of the foregoing it is believed that claims 1-2, 8-11, and 13-18 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: April 6, 2007

Respectfully submitted,

By 

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